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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/735,931	12/14/2000	Ryoh Itoh	K-1948	5805
7590 11/26/2003				
KANESAKA AND TAKEUCHI		EXAMINER		
Suite 2		TALBOT, BRIAN K		
1423 Powhatan Street		ART UNIT		
Alexandria, VA 22314		PAPER NUMBER		
		1762		

DATE MAILED: 11/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/735,931

Applicant(s)

ITOH, RYOH

Examiner

Brian K Talbot

Art Unit

1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \*   c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/27/03 has been entered.

2. Claims 1-11 remain in the application.

***Claim Rejections - 35 USC § 103***

3. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admitted state of the art (pgs. 1-4) in combination wither either Kawagishi et al. (4,940,608) or Grosclaude (5,388,754) or Kanoh et al. (5,989,787).

Applicant's admitted state of the art (pgs. 1-4) teaches selective coating of substrates including the steps of roughening, masking, catalyst, plating and removing the mask and catalyst. The sequence of steps can vary to achieve the desired coating pattern.

Applicant's admitted state of the art (pgs. 1-4) fails to teach a masking coating which is water soluble or hydrolyzable.

Kawagishi et al. (4,940,608) or Grosclaude (5,388,754) or Kanoh et al. (5,989,787) all teach masking coating which are hydrolyzable and can be removed by water or a solution including water.

Therefore, it would have been obvious for one skilled in the art at the time the invention was made to have modified Applicant's admitted state of the art (pgs. 1-4) process by substituting a water soluble or hydrolysable masking coating as evidenced by Kawagishi et al. (4,940,608) or Grosclaude (5,388,754) or Kanoh et al. (5,989,787) because of the advantages associated with their use, i.e. ease of removal, less contamination, less potential damage to substrate, etc.

***Response to Amendment***

4. Applicant's arguments filed 8/28/03 and 10/27/03 have been fully considered but they are not persuasive.

Applicant argued (pg. 8, lines 1-8) that the references fail to teach removing the water soluble polymer by "water only" (emphasis added).

Applicant arguments are not commensurate in scope with the claims.

Claim 1 states:

a coated material removing process for entirely removing the coating material applied on the predetermined coating area of the base in the coating process by washing with liquid containing water. (underlining added for emphasis).

Applicant argued that the prior art teaches a curing step, which is not present in the application.

Again, Applicant's arguments are not commensurate in scope with this argument. The claims are not limited to excluding a curing step.

Applicant argued that the secondary prior art fails to teach injection molding the coating material.

While the Examiner acknowledges this fact, the primary reference teaches injection molding (further acknowledge on pg. 10, last full paragraph of response filed 2/13/03). The secondary references are cited as teaching water soluble or hydrolysable coating and not for the techniques utilized to deposit them.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian K Talbot whose telephone number is (703) 305-3775. The examiner can normally be reached on Monday-Friday 6AM-3PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P Beck can be reached on (703) 308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3775.

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Art Unit: 1762

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Brian K Talbot  
Primary Examiner  
Art Unit 1762

BKT  
November 21, 2003